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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/816,635

04/02/2004

Robert Greer

0644-08

1050

7590

01/22/2007

Walter L. Beavers  
326 South Eugene Street  
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EXAMINER

DICUS, TAMRA

ART UNIT

PAPER NUMBER

1774

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/22/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/816,635

Applicant(s)

GREER ET AL.

Examiner

Tamra L. Dicus

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 18-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 1-17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 09-29-06, 01-23-06, 4-02-04.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

***DETAILED ACTION***

The election of group I, claims 1-17, without traverse is acknowledged.

***IDS***

The information disclosure statement filed 09-26-06 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the number and name do not correspond. It appears to be an erroneous number, thus the relevance is not clear. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

***Claim Objections***

Claim 1 is objected to because of the following informalities: Instant claim 1 recites in line 3, "said first section contiguous said second section...". It appears the grammar is not correct.. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13, 11, and 14-15, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 recites the top and bottom are coplanar with said first thermoplastic section, but does not recite which surface the second is coplanar with and to (the top surfaces of the second section are both top and bottom as is the first surface and the claim does not state which surfaces of the second are in conjunction with the first surfaces). Thus, the overall structure is not clear.

Claim 14 recites "approximately the same", which is an ambiguous because the limitation provides no direction to the degree. The term "approximately the same" is indefinite as the specification does not provide a definition to the metes and bounds of the phrase. In order to determine infringement of the present claims, one necessarily would need to determine with a reasonable degree of certainty the scope of the phrase "approximately the same." Applicant has failed to provide any such guidance and, accordingly, this phrase renders the scope of the claims unclear.

Claims 11 and 15 recite "string-like shape", which is indefinite. The phrase "string-like" renders the claim(s) indefinite because the claims include elements not actually disclosed (those encompassed by "type"), thereby rendering the scope of the claims unascertainable. See *Ex parte Copenhaver*, 109 USPQ 118 (Bd. App. 1955).

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***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Harper.

Harper teaches all the limitations of instant claims 1-4 to a pavement marking illustrated in FIGS 2-3 and associated text. Specifically, 18 (first section, polyurethane), 16 (second section, paraffin resin, polyester), with adhesive between (7:55-68, 8:15-68). The adhesive is a PSA type or contact adhesive, because the material is the same it is capable of being sprayable. Instant claims 1-4 and 7 are met.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harper in view Buccellato et al.

Harper essentially teaches the claimed invention.

Harper is silent to a type of adhesive used or sprayable feature, while stating PSA types can be employed (instant claims 5-7).

Buccellato teaches an adhesive composition of PSA polymers such as acrylic in a dot or stripe pattern and sprayable types see 3:54-4:68, 8:1-36 (inclusive of thermosetting and thermoplastic and sprayable (dot pattern)).

It would have been obvious to one having ordinary skill in the art to have modified the Harper pavement marking to use the adhesive of Buccellato in a dot or stripe pattern because the advantages are high shear force when tires hit pavement and high tack applied to any form/shape of pavement article (2: 45-60, 3:1-25, 3:54-4:68, 8:1-36, Examples).

Claims 8-15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harper in view Buccellato et al.

Harper teaches all the limitations of instant claim 8 and 13 to a pavement marking illustrated in FIGS 2-3 and associated text except for a spray(ed) adhesive. Specifically, 18 (first section, polyurethane, polyamide), 16 (second section, paraffin resin, polyolefin, or polyester), with adhesive between (5:1-20, 7:55-68, 8:15-68). The adhesive is a PSA type or contact adhesive. Harper shows the plurality of second sections as recited per instant claim 12 in FIG. 3.

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Harper is silent to a type of adhesive used or sprayed feature, string shape while stating PSA types can be employed (instant claims 8-11, 13-15).

Buccellato teaches an adhesive composition of PSA polymers such as acrylic and acrylamide (polyamide), and ethylene glycol (polyolefin) in a dot or stripe pattern and sprayable types see 3:54-4:68, 5:1-35, 8:1-36 (inclusive of thermosetting and thermoplastic and sprayed (dot pattern)) on or under pavement markings. Method steps (sprayed) included in a product claim are product by process limitations and are given little patentable weight. The same structure and materials are provided, thus the Applicant's product and the prior art product is the same. See MPEP 2113.

It would have been obvious to one having ordinary skill in the art to have modified the Harper pavement marking to use the adhesive of Buccellato in a dot or stripe pattern and shape as claimed because the advantages are high shear force when tires hit pavement and high tack applied to any form/shape of pavement article to adhere to a road (2: 45-60, 3:1-25, 3:54-4:68, 5:1-35, 8:1-10, 16:1-68, Examples).

Further to instant claim 14, polyamide and polyolefin polyethylene are thermoplastics included in the adhesive, both polymers of first and second sections, respectively, the softening points are inherent and are considered approximately the same.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harper in view Buccellato et al. and further in view of Wiley.

The combination is relied upon above.

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The combination is silent to grid patterns as per instant claim 16.

Buccellato suggests the pavement marking has good adhesion to in particular, substrates such as asphalt and cement concrete (2:45-50).

Wiley teaches inlaid patterns in asphalt or thermoplastic surfaces using thermoplastic grids (two) to impress corporate logos or decorative designs in pavements (3:10-68, see also 3:54-68).

It would have been obvious to one having ordinary skill in the art to have modified the combination to further include grid(s) as claimed because Wiley teaches they imprint a desired pattern such as grid lines or decorative designs in pavements.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Tamra L. Dicus  
Examiner  
Art Unit 1774

January 4, 2007



RENA DYE  
SUPERVISORY PATENT EXAMINER

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